

Appln. No. 10/751,561
Response dated 10 August 2006
Reply to Office Action of 10 May 2006

REMARKS/ARGUMENTS

Applicants thank the Office for indicating that Claims 15-22 are allowed. However Applicants question whether there has been an error since the previous Office Action, dated November 22, 2005, also reported that Claims 15-26 are allowed.

The Office has objected to Claim 1 due to the perceived informality that a "(c)" option should be placed just after the "or" in line 15 of Claim 1. Applicants respectively submit, however, that no further option is intended to be identified and that the "(c)" is not necessary. The language specific to option "(b)" is intended to conclude with the words "second ends," and the remainder of the claim beginning with the words "the body . . ." is intended to apply no matter whether option (a) or (b) is employed in the body. It is not intended for there to be a third option listed in Claim 1.

The Office has also objected to Claims 14 and 23-26 as being in improper form due to being multiple dependent claims that are dependent upon multiple dependent claims. Applicants have, therefore, amended Claim 14 so that it is no longer a multiple dependent claim. As to Claims 23-26, Applicants respectfully submit that none of these claims are improper under 37 CFR 1.75(c) because none that are multiple dependent depend, themselves, from multiple dependent claims. In addition, as noted above, since the previous Office Action, dated November 22, 2005, had reported that Claims 23-26 are already allowed, Applicants respectfully request that such claims be noted by the Office as having previously been considered on their merits and allowed.

The Office has also rejected Claims 1-14 under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5,867,956 (Gregory) in view of either US Pat. No. 6,679,018 (Georgeau) or US Pat. No. 3,879,508 (Gilbert). Applicants respectfully submit that Gregory, in view of Georgeau or Gilbert, fails to substantiate an assertion of prima facie obviousness, much less obviousness under 35 USC 103(a). Gregory discloses use of paper or plastic as suitable materials for perforated corrugations used as ventilation baffles and does not teach or suggest to a skilled artisan the use of a non-perforated film. Gregory also fails to recognize or address a need for an

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insulation dam in addition to the need for ventilation. In addition, Gregory teaches use of either fiberglass bats or rigid foam planks, "such as STYROFOAM® planks", as insulation materials (see Gregory, column 2, lines 34 – 36). This is contrary to Applicants' claimed invention which employs a flexible polyolefin foam body. In fact, such Gregory insulation material is specifically identified in Applicants' Specification as a material that will not work for Applicants' invention. For example, see: Page 3, line 19 through Page 4, line 18, and "Comp Ex A", beginning on Page 27, line 15. In Applicants' Specification, it is described how polystyrene foam sheeting tends to be fracture or break when subjected to a bending stress about a sharp edge such as would be encountered if one were to try to bend the sheet against the upper wall plate of a gabled or sloping roof in order to make the sheet function as both a vent panel and an insulation dam. For example, "Comp Ex A" demonstrates that, when a polystyrene foam is employed: "The thermoformed sheet, when bent at a 90° angle, evidences irregular cracking and some fracturing. Bending the sheet at a lesser angle to avoid such cracking and fracturing allows the sheet to rebound almost to its unbent shape, if not fully to its unbent shape, but renders the sheet unsuitable for use as a substitute for the foam of Ex. 1. Adding hinge or fold lines and avoiding multiple flexures of the sheet about the hinge or fold lines reduces the tendency toward cracking or fracturing, but effectively destroys the ability of the sheet to rebound by as much as 25%, if it rebounds at all." Gregory, however, provides no teaching or suggestion to motivate a skilled artisan to even try using a flexible polyolefin foam. Applicants submit that this is due, in part, to the fact that Gregory fails to recognize or address a need for an insulation dam in addition to the need for ventilation.

Furthermore, Georgeau (US Patent 6,679,018) adds nothing to the teachings of Gregory that bolsters an assertion of prima facie obviousness. Georgeau addresses materials to be placed on top of the upper surface of the roof deck and uses a rigid insulation board. Nothing in Georgeau recognizes or addresses the problem solved by Applicant's claimed invention or guides a skilled artisan to ignore the clear requirement for a rigid foam in favor of a flexible foam or to explore problems beneath a roof deck's lower surface. As such, Georgeau fails to establish even prima facie obviousness, either alone or in combination with Gregory.

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Gilbert, whether taken alone or in conjunction with Georgeau, fails to overcome shortcomings evident in a comparison of Crookston's teachings with Applicants' pending claims. Gilbert discloses corrugated foamed thermoplastic resin sheet (see Claim 1). Gilbert defines "sheet" as having a maximum thickness of 0.5 inch at column 3, lines 1-8. Although Gilbert mentions use of the corrugated foam in roof insulation at column 4, lines 50-51, nothing in Gilbert suggests that such roof insulation be placed in any location other than atop a roof deck as also taught by Georgeau. While Gilbert introduces flexible foams at column 2, lines 49-50, nothing in Gilbert pushes a skilled artisan to substitute a flexible polyolefin foam for the insulation materials mandated by Gregory. Finally, the foam sheet of Gilbert has a thickness of no more than half of the thickness specified in pending Claim 5. Based upon the foregoing differences, with no teaching or suggestion in any of Gilbert, Georgeau, or Gregory to guide a skilled artisan to overcome the differences, the cited combination fails to establish prima facie obviousness and Applicants' pending Claims 1-14 are patentable over the cited references.

In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention. The references, themselves, must suggest the desirability of the modifications. See *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."). However, there is nothing within Gregory, Gilbert, or Georgeau that recognize and/or attempt to solve the problem that is solved by Applicants' invention and there is insufficient impetus to have led one of ordinary skill in the art to combine the various teachings of these references to make the claimed invention. Even if one were to improperly use hindsight analysis to separately select individual components from the cited references, the resultant modification or combination would still fall short of yielding Applicants' claimed invention.

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Applicants respectfully ask the Office to withdraw the rejections of Claims 1-14 under 35 USC 103(a) and to allow Claims 1-14 together with allowed Claims 15-26 at an early date.

Respectfully submitted,


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